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EXAMINER

MARSCHEL, A

ART UNIT	PAPER NUMBER
1807	6

DATE MAILED: 08/12/92

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

08/12/92

- ☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner; PTO-892.
- ☐ Notice re Patent Drawing, PTO-948.
- ☒ Notice of Art Cited by Applicant; PTO-1448. (11 sheets)
- ☐ Notice of Informal Patent Application, Form PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

- ☒ Claims 1-16 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
- ☐ Claims _____ have been cancelled.
- ☐ Claims _____ are allowed.
- ☒ Claims 1-16 are rejected.
- ☐ Claims _____ are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
- ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The claimed invention is an apparatus and a method which is not what is stated in the title.

This application does not contain an Abstract of the Disclosure as required by 37 C.F.R. § 1.72(b). An Abstract on a separate sheet is required.

Claims 1-16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 3, the phrase "a chosen part" is cited. It is unclear whether applicant means the practice of this phrase to be that of selecting oligonucleotides out of the "set of oligonucleotides" cited in claim 1, line 3, or whether the "chosen part" is meant to be a segment out of one of the oligonucleotides. Clarification is requested as what applicant means to claim. This wording is confusing specifically in claims 2, 8 and 9 also.

In claim 2, lines 4-5, the phrase "polynucleotide sequences" is cited as if it is a composition. A sequence of a polynucleotide is a characteristic of a polynucleotide and not a composition. This phraseology makes claim 2 and others wherein this type of phrase is used vague and indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under

this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6, and 8-10 are rejected under 35 U.S.C.

§ 102(b) as being anticipated by Brigati et al.

Brigati et al. discloses the in-situ hybridization of probes to detect immobilized viral genomes located within cells attached to a solid support. Due to the unclear definition of cells in the instant invention, one interpretation is that different cells may contain viral genomes that are detectable by in-situ hybridization as disclosed in the abstract of Brigati et al. as well as pictorially in Figure 4 on page 40. The viral genomes are of chosen length since the virus to be detected to a chosen type with its inherent genome length. The viral genomes are capable of taking part in hybridization reactions. In summary the in-situ hybridization disclosure of Brigati et al. reads on the instant claims.

Claims 1-4 and 8-11 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Saiki et al.

Figures 2 and 5 on pages 164 and 165, respectively, of Saiki et al. show separate immobilization of chosen nucleic acids which have been labelled by hybridization to labelled probes. Normal and mutant versions of the immobilized nucleic acids are disclosed. These arrays read on the instantly rejected claims.

Claims 1-14 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-14 of copending application Serial No. 07/573,317. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The disclosure is objected to because of the following informalities:

In claim 2, line 5, the word "diferent" appears to be misspelled.

Appropriate correction is required.

Claims 5, 7, and 12-16 are allowable over the prior art of record.

No claim is allowed.

Papers related to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

The CM1 Fax Center number is (703) 308-4227.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

AM
A. MARSCHEL:am
August 10, 1992


MARGARET MOSKOWITZ
SUPERVISORY PATENT EXAMINER
GROUP 180